

Appellant: Cary L. Bates Page 3
Serial No.: 10/798,909
Filed: March 11, 2004 Docket: ROC920030376US1
Title: Password Protection Mechanism

S/N 10/798,909

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Cary L. Bates	Examiner: April Ying Shan
Serial No.: 10/798,909	Group Art Unit: 2135
Filed: March 11, 2004	Confirmation Number: 6995
	Docket: ROC920030376US1
Title: Password Protection Mechanism	

APPEAL BRIEF
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES
OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This brief is presented in support of the Notice of Appeal filed on January 21, 2009, from the Final Rejection of claims 1-5 of the above-identified application, as set forth in the Final Office Action mailed on September 17, 2008.

Please charge \$540.00 to Deposit Account 09-0465 to cover the fee for filing an appeal brief. Please charge any additional fees or credit overpayment to Deposit Account 09-0465. Appellant respectfully requests reversal of the Examiner's rejection of pending claims 1-5.

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1. Real Party in Interest

The real party in interest, in addition to the inventors, Cary L. Bates and Paul W. Buenger, is the assignee, International Business Machines Corporation, a corporation organized and existing under and by virtue of the laws of the State of New York, and having an office and place of business at New Orchard Road, Armonk, New York 10504.

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2. Related Appeals and Interferences

There are no other prior or pending appeals, interferences, or judicial proceedings, which may be related to, directly affect or be directly affected by, or have a bearing on the Board's decision.

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3. Status of Claims

On January 21, 2009, appellant appealed from the final rejection of claims 1-5 made in the Final Office Action dated September 17, 2008. Claims 6-20 were canceled without prejudice or disclaimer. Finally rejected claims 1-5 on appeal are set forth in the Claims Appendix.

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4. Status of Amendments

Subsequent to the Final Office Action dated September 17, 2008, appellant did not file any amendments.

5. Summary of Claimed Subject Matter

As described, by way of example and not of limitation, at page 3, lines 1-8 of appellant's specification and as illustrated, by way of example and not of limitation, at Fig. 1, elements 101, 102, 170, 172, 174, and 176, at Fig. 2, elements 200, 205, 210, 215, and 220, at Fig. 3A, elements 172, 305, 310, 315, and 320, at Fig. 3B, elements 174, 355, 360, 365, and 370, at Fig. 4A, elements 176-1 and 405, at Fig. 4B, elements 176-2 and 450, at Fig. 5, elements 515, 520, 530, 535, 540, and 550, at Fig. 6A, elements 605, 610, 615, 620, 625, 630, 635, 640, and 645, and at Fig. 6B, elements 650, 655, 660, 665, and 670, "A method ... [is] provided that in an embodiment determine[s] whether a password is restricted to a set of pages, deny submission of the password outside the set of pages if the password is restricted, and allow submission of the password outside the set of pages if the password is not restricted. In various embodiments, the set of pages includes all pages in a domain or only a single page. In various embodiments, restriction of the password may be specified via control information in a page or via a user interface."

With reference to claim 1, an embodiment of the invention comprises a method, which is described, by way of example and not of limitation, in the specification, at page 3, line 2, at page 4, lines 14-27, at page 5, lines 1-26, at Fig. 1, elements 101, 102, 170, and 172, at Fig. 5, elements 505, 510, 515, 520, 525, 530, 535, 540, and 550, at Fig. 6A, elements 605, 610, 615, 620, 625, 630, 635, 640, and 645, and at Fig. 6B, elements 650, 655, 660, 665, and 670.

The method of claim 1 comprises receiving a form at a client, wherein the form requests that a first password be submitted to a server, which is described, by way of example and not of limitation, in the specification, at page 1, lines 17-19, at page 2, lines 23-24, at page 4, lines 6-9, at page 7, lines 19-22, at page 12, lines 4-8, at page 13, lines 1-11 and 25-28, at page 14, lines 1-5, at Fig. 1, elements 100, 101, 102, 160, 170, and 172, at Fig. 5, elements 505, 510, 530, and 535, and at Fig. 6A, elements 605, 610, and 615.

With further reference to claim 1, the method further comprises determining whether the first password is restricted to a set of pages, wherein the determining further comprises in response to each of the pages in the set being retrieved from the server, determining whether

at least one of the pages in the set comprises a meta tag that includes password restriction control information that specifies an address of a domain and restriction of password submission to within the domain, wherein the pages in the set are interpreted and displayed at the client after being retrieved from the server, which is described, by way of example and not of limitation, in the specification, at page 1, lines 17-19, at page 2, lines 22-26, at page 3, lines 2-8, at page 5, lines 15-26, at page 7, lines 15-26, at page 10, lines 12-27, at page 11, lines 1-8 and 21-26, at page 12, lines 4-26, at Fig. 1, elements 100, 101, 102, 121, 122, 123, 124, 160, 168, 170, 172, 174, and 176, at Fig. 2, elements 205 and 210, at Fig. 3A, elements 172, 305, 310, 315, and 320, at Fig. 3B, elements 174, 360, 365, and 370, at Fig. 4A, elements 176-1 and 405, and at Fig. 5, elements 505, 510, 515, 520, and 525.

With further reference to claim 1, the method further comprises if the first password is restricted to the set of pages, denying submission of the first password outside the set of pages, wherein the first password is allowed to be submitted to the server that originated the set of pages, which is described, by way of example and not of limitation, in the specification, at page 3, lines 1-5, at page 10, lines 12-27, at page 11, lines 1-29, at page 12, lines 1-29, at page 13, lines 1-12 and 25-28, at page 14, lines 1-28, at page 15, lines 1-28, at page 16, lines 1-8, at Fig. 2, elements 205, 210, 215, and 220, at Fig. 3A, elements 172, 305, 310, 315, and 320, at Fig. 3B, elements 174, 355, 360, 365, and 370, at Fig. 4A, elements 176-1 and 405, at Fig. 5, elements 505, 510, 530, and 535, at Fig. 6A, elements 605, 610, 615, 620, 625, 630, 635, and 640, and at Fig. 6B, elements 650, 655, 660, 665, and 670.

With further reference to claim 1, the method further comprises if the first password is not restricted to the set of pages, allowing submission of the password outside the set of pages, which is described, by way of example and not of limitation, in the specification, at page 3, lines 1-5, at page 10, lines 12-27, at page 11, lines 1-29, at page 12, lines 1-29, at page 13, lines 1-12 and 25-28, at page 14, lines 1-28, at page 15, lines 1-28, at page 16, lines 1-8, at Fig. 2, elements 205, 210, 215, and 220, at Fig. 3A, elements 172, 305, 310, 315, and 320, at Fig. 3B, elements 174, 355, 360, 365, and 370, at Fig. 4A, elements 176-1 and 405, at Fig. 5, elements 505, 510, 530, and 535, at Fig. 6A, elements 605, 610, 615, 620, 625, 630, 635, and 640, and at Fig. 6B, elements 650, 655, 660, and 665.

With further reference to claim 1, the method further comprises denying submission of a second password inside the set of pages if the second password was previously submitted outside the set of pages, which is described, by way of example and not of limitation, in the specification, at page 3, lines 1-5, at page 10, lines 12-27, at page 11, lines 1-29, at page 12, lines 1-29, at page 13, lines 1-12 and 25-28, at page 14, lines 1-28, at page 15, lines 1-28, at page 16, lines 1-8, at Fig. 2, elements 205, 210, 215, and 220, at Fig. 3A, elements 172, 305, 310, 315, and 320, at Fig. 3B, elements 174, 355, 360, 365, and 370, at Fig. 4A, elements 176-1 and 405, at Fig. 5, elements 505, 510, 530, and 535, at Fig. 6A, elements 605, 610, 615, 620, 625, 630, 635, and 640, and at Fig. 6B, elements 650, 655, 660, 665, and 670.

With further reference to claim 1, the method further comprises allowing submission of the second password inside the set of pages if the second password was not previously submitted outside the set of pages, which is described, by way of example and not of limitation, in the specification, at page 3, lines 1-5, at page 10, lines 12-27, at page 11, lines 1-29, at page 12, lines 1-29, at page 13, lines 1-12 and 25-28, at page 14, lines 1-28, at page 15, lines 1-28, at page 16, lines 1-8, at Fig. 2, elements 205, 210, 215, and 220, at Fig. 3A, elements 172, 305, 310, 315, and 320, at Fig. 3B, elements 174, 355, 360, 365, and 370, at Fig. 4A, elements 176-1 and 405, at Fig. 5, elements 505, 510, 530, and 535, at Fig. 6A, elements 605, 610, 615, 620, 625, 630, 635, and 640, and at Fig. 6B, elements 650, 655, 660, 665, and 670.

With further reference to claim 1, the method further comprises if the at least one of the pages in the set comprises the password restriction control information that specifies the address of the domain and the restriction of the password submission to within the domain, saving the address of the domain and saving an indication that password use is to be restricted for all the pages in the domain pages, which is described, by way of example and not of limitation, in the specification, at page 3, lines 1-5, at page 10, lines 12-27, at page 11, lines 1-29, at page 12, lines 1-29, at page 13, lines 1-12 and 25-28, at page 14, lines 1-28, at page 15, lines 1-28, at page 16, lines 1-8, at Fig. 3A, elements 172, 305, 310, 315, and 320, at Fig. 3B, elements 174, 355, 360, 365, and 370, at Fig. 4A, elements 176-1 and 405, at Fig. 5, elements 505, 510, 515, and 520.

With reference to claim 2, the set of pages comprises all pages within the domain, which is described, by way of example and not of limitation, in the specification, at page 3, lines 2-7, at page 10, lines 21, at page 16, lines 5-8, at Fig. 1, element 176, and at Fig. 4A, elements 176-1 and 405.

With reference to claim 3, the set of pages comprises a single page, which is described, by way of example and not of limitation, in the specification, at page 3, lines 2-7, at page 10, lines 21, at page 16, lines 5-8, and at Fig. 1, element 176, and at Fig. 4B, elements 176-2 and 450.

With reference to claim 4, the method further comprises presenting a dialog at the client, wherein the dialog allows a user to specify an address of a domain for which password submission is to be restricted, which is described, by way of example and not of limitation, in the specification, at page 1, lines 17-19, at page 7, lines 19-22, at page 10, lines 12-25, at Fig. 1, elements 100, 121, 122, 123, and 124, and at Fig. 2, elements 200, 205, and 210.

With reference to claim 5, the method further comprises presenting a dialog at the client, wherein the dialog allows a user to specify an address of a single page for which password submission is to be restricted, which is described, by way of example and not of limitation, in the specification, at page 1, lines 17-19, at page 7, lines 19-22, at page 10, lines 12-25, at Fig. 1, elements 100, 121, 122, 123, and 124, and at Fig. 2, elements 200, 215, and 220.

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6. Grounds of Rejection to be Reviewed on Appeal

1. Whether claims 1-5 are unpatentable under 35 U.S.C. 102(e) over Wood (US Patent Number 6,609,198).

7. Argument

A) The Applicable Law

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

In order for the Examiner to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when

combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979)).

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994); *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966); *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969); *In re Caldwell*, 319 F.2d 254, 256, 138 USPQ 243, 245 (C.C.P.A. 1963).

The test for obviousness under § 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). Furthermore, claims must be interpreted in light of the specification, claim language, other claims and prosecution history. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987), *cert. denied*, 481 U.S. 1052 (1987). At the same time, a prior patent cited as a § 103 reference must be considered in its entirety, "i.e. as a whole, including portions that lead away from the invention." *Id.* That is, the Examiner must, as one of the inquiries pertinent to any

obviousness inquiry under 35 U.S.C. § 103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990). Finally, the Examiner must avoid hindsight. *Id.*

The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. But, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In *re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Further, "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

B) Discussion of the Rejections

1. Claims 1-5 are rejected as unpatentable under 35 U.S.C. 102(e) over Wood (US Patent Number 6,609,198), hereinafter "Wood."

Claim 1

Claim 1 recites: "denying submission of a second password inside the set of pages if the second password was previously submitted outside the set of pages; allowing submission of the second password inside the set of pages if the second password was not previously submitted outside the set of pages."

The Examiner relies on Wood at column 3, lines 59-60, which merely recites: "The information resources have individualized authentication requirements."

Wood defines its authentication requirements at column 2, lines 32-35 which recites: "Authentication schemes (e.g., those based on passwords, certificates, biometric techniques, smart cards, etc.) are associated with trust levels and environmental parameters."

Wood defines its trust levels at column 2, lines 50-56, which recites: "An entity (e.g., a user or an application) may initially log-on with a credential suitable for one or more resources in an initial resource set, but then require access to resource requiring authentication at higher trust level. In such case, the log-on service allows additional credentials to be provided to authenticate at the higher trust level."

Wood defines its environmental parameters at column 6, lines 54-58, which recites: "the mapping of login credential types and authentication mechanisms to trust levels is influenced by environment information such as time of request, source of request, connection speed, and/or client application (e.g., browser) environment information."

Thus, the Wood "individualized authentication requirements" are based on "passwords, certificates, biometric techniques, smart cards," "time of request, source of request, connection speed, and/or client application," and a higher trust level has additional credentials, none of which are related to whether or not a password as been previously submitted outside of a set of pages, so Wood does not teach or suggest "denying submission of a second password inside the set of pages if the second password was previously submitted outside the set of pages; allowing submission of the second password inside the set of pages if the second password was not previously submitted outside the set of pages," as recited in claim 1.

Further, Wood does not compare passwords that were submitted to different information resources. Instead, Wood processes the credentials for its client entities individually and not in relation to each other. For example, at column 3, lines 60-62, Wood "obtains a first credential for the client entity, authenticates the client entity thereby." Then, at column 3, line 65 and column 4, lines 1-3, Wood "obtains a second credential for the client entity, authenticates the client entity thereby, and upgrades the session to the second authentication level," but Wood does not compare its first and the second credentials, so Wood cannot possibly teach or suggest "denying submission of a second password inside the set of pages if the second password was previously submitted outside the set of pages; allowing submission of the second password inside the set of pages if the second password was not previously submitted outside the set of pages," as recited in claim 1.

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In addition, since Wood “upgrades the session to the second authentication level” in response to the authentication of the “client entity” via the “second credential,” as described at column 3, lines 67 and line 4, lines 1-2, Wood is accepting its second credential, in opposition to “denying submission of a second password,” as recited in claim 1.

Thus, Wood does not teach or suggest all elements of claim 1.

Claims 2-5

Claims 2-5 are dependent on claim 1 and are patentable for the reasons argued above.

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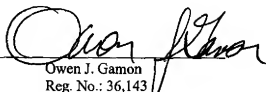
Conclusion

Appellant respectfully requests reversal of the above rejections. If the Board is of the opinion that any rejected claim may be allowable in amended form, then appellant also respectfully requests a statement to that effect.

Respectfully submitted,

Date April 21, 2009

By



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Name Owen J. Gamon

Signature



8. CLAIMS APPENDIX

I. A method comprising:

receiving a form at a client, wherein the form requests that a first password be submitted to a server;

determining whether the first password is restricted to a set of pages, wherein the determining further comprises in response to each of the pages in the set being retrieved from the server, determining whether at least one of the pages in the set comprises a meta tag that includes password restriction control information that specifies an address of a domain and restriction of password submission to within the domain, wherein the pages in the set are interpreted and displayed at the client after being retrieved from the server;

if the first password is restricted to the set of pages, denying submission of the first password outside the set of pages, wherein the first password is allowed to be submitted to the server that originated the set of pages;

if the first password is not restricted to the set of pages, allowing submission of the password outside the set of pages;

denying submission of a second password inside the set of pages if the second password was previously submitted outside the set of pages;

allowing submission of the second password inside the set of pages if the second password was not previously submitted outside the set of pages; and

if the at least one of the pages in the set comprises the password restriction control information that specifies the address of the domain and the restriction of the password submission to within the domain, saving the address of the domain and saving an indication that password use is to be restricted for all the pages in the domain.

2. The method of claim 1, wherein the set of pages comprises all pages within the domain.

3. The method of claim 1, wherein the set of pages comprises a single page.

4. The method of claim 1, further comprising:

presenting a dialog at the client, wherein the dialog allows a user to specify an address of a domain for which password submission is to be restricted.

5. The method of claim 1, further comprising:

presenting a dialog at the client, wherein the dialog allows a user to specify an address of a single page for which password submission is to be restricted.

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9. EVIDENCE APPENDIX

None.

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10. RELATED PROCEEDINGS APPENDIX

None.